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09/629,492	07/31/2000	Juei Chang	P3925	4269

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,492

Applicant(s)

CHANG ET AL.

Examiner

Joshua D Campbell

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed on 11/15/2004.
2. Claims 1-2, 4-7, 9-11, and 13-20 are pending in this case. Claims 1 and 10 are independent claims. Claims 3, 8, and 12 have been cancelled. Claim 17 has been amended.
3. The rejection of claim 17 under 35 U.S.C. 112 second paragraph as being indefinite has been withdrawn due to the amendment.

Claim Rejections - 35 USC § 112

4. Claims 1, 2, 4-7, and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. As stated in the final limitation of claim 1, "...wherein the software-bundle functions as a fully automated navigation system capable of performing all of the functions of a manual navigation system controlled by a user having a data-input system for controlling the navigation system and the set of machine-readable instructions provided from an external source other than the control application," the invention must be capable of performing "all" of the functions of a manual navigation system. However, the specification does not clearly state what all of the functions of a manual navigation system are, nor does it state how the invention supports each and

every function of a manual navigation system. Thus, rendering this claim indefinite due to the lack of enablement. In order to further prosecution, the claim will be interpreted as automating the functionality of a navigation system in such a way that allows the system to perform normal actions automatically.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 4-7, and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed subject matter is non-statutory because it is not tangibly embodied in a manner so as to be executable (i.e. stored on a recordable medium). A software-bundle is non-statutory subject matter unless it is tangibly embodied on a recordable medium. In order to overcome this rejection proper correction is required.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 4-7, 9-11, and 13-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Burson et al. (US Patent Number 6,405,245, filed on October 28, 1998).

7. **Regarding independent claim 1,**

- a browser application for navigating on the network;
 - Burson et al. discloses a method which includes the use of a browser application to navigate on a network (internet) (column 4, lines 36-65 of Burson et al.);
- a set of functional programs for performing tasks;
 - Burson et al. discloses a method in which processing components (functions) of a PI engine are used to perform tasks (column 4, line 66-column 5, line 21 of Burson et al.);
- a set of APIs for integrating the functional programs to the browser application;
 - Burson et al. discloses a method in which the processing components are integrated into browser functionality (column 4, lines 36-65 of Burson et al.). Burson et al. does not disclose the use of an API for integration purposes. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate processing components (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide communication between applets in Java virtual machine; and
- the browser application utilizes the APIs and functional programs during a navigation sequence according to a machine-readable set of instructions;
 - Burson et al. discloses a method in which the processing components (programs) are integrated into browser functionality (column 4, lines 36-65

of Burson et al.). The PI that is obtained using the PI engine contains additional instructions on how to execute transactions (column 4, line 66-column 5, line 21 of Burson et al.). Burson et al. does not disclose the use of an API for integration purposes. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate processing components.

- a control application for spawning, managing and terminating an instance of the browser application and monitoring behavior of the browser instance during a navigation sequence, such that the software-bundle functions as a fully automated navigation system capable of performing all of the functions of a manual navigation system controlled by a user having a data-input system for controlling the navigation system;
 - o Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.).

- the set of machine-readable instructions is provided from an external source other than the control application;
 - o Burson et al. discloses a method in which additional procedures necessary to complete a transaction may be contained within the PI store (column 4, line 66-column 5, line 21 of Burson et al.).

8. Regarding dependent claim 2,

- the data network is the Internet network;
 - o Burson et al. discloses a method which includes the use of a browser application to navigate on the internet (column 4, lines 36-65 of Burson et al.).

9. Regarding dependent claim 4,

- the set of machine-readable instructions is provided to the bundle by the control application;
 - o Burson et al. discloses a method in which the PI engine (control application) is made of processing components (programs) to execute tasks (column 6, lines 24-65 of Burson et al.). It is inherent that a program operated by a computer is in the form of machine-readable instructions.

10. Regarding dependent claims 5 and 6,

- the set of machine-readable instructions covers a single navigation sequence;
- the set of machine-readable instructions covers a series of navigation sequences;

- Burson et al. discloses a method in which a user can specify what navigation sequences to perform (one or more) (column

11. Regarding dependent claims 7 and 9,

- the bundle resides on a single processor and includes an instance of the control application; and
- the software-bundle shares a control application with other like software-bundles executing on other processors;
 - Burson et al. discloses a method in which the PI engine can execute on a single processor and multiple processors (column 6, lines 24-65 of Burson et al.).

12. Regarding independent claim 10,

- providing a machine-readable set of instructions for initiating, running, and closing the navigation sequence;
- executing an instance of a browser application, the execution resulting from receipt of the machine-readable set of instructions;
- executing and completing a series of tasks during the navigation sequence according to the order of instruction contained in the machine-readable set of instructions;
- terminating the instance of browser application, the termination resulting from the completion of the machine-readable set of instructions by the instance of browser application;

- o Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.). Burson et al. does not disclose the use machine-readable instructions to operate the control application. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made that a program, such as a control application (PI engine), operated by a computer would be in the form of machine-readable instructions.
- the machine-readable set of instructions is provided by a software-control application;
 - o Burson et al. discloses a method in which the PI engine (control application) is made of processing components (programs) to execute tasks (column 6, lines 24-65 of Burson et al.). It is inherent that a program operated by a computer is in the form of machine-readable instructions.

13. Regarding dependent claim 11,

- the data network is the Internet network;

- o Burson et al. discloses a method, which includes the use of a browser application to navigate on the internet (column 4, lines 36-65 of Burson et al.).

14. Regarding dependent claims 13-16,

- the machine readable instructions provide for monitoring the navigation sequence by the software control application;
- the machine-readable set of instructions contains a first instruction for spawning an instance of the browser application;
- the machine-readable set of instructions contains a last instruction for closing an instance of the browser application;
- the browser instance is spawned by the software-control application; and
- the browser instance is terminated by the software-control application;
 - o Burson et al. discloses a method in which a PI (personal information) engine (control application) will perform browser transactions invisible to the user (column 7, lines 30-67). The PI engine generates a simulated web client (browser instance) to perform tasks which are monitored, and when the task is completed the data is returned to the user interface of the browser application at which point the simulated web client is terminated and control is returned to the user interface (column 7, lines 30-67 of Burson et al.).

15. Regarding dependent claims 17 and 18,

- APIs further provide automated extensibility to the browser instance by accessing and utilizing Java based routines that are used during navigation on a network;
- APIs extend automated browser functions by including at least one of searching Web site destinations, emulating all user input actions, error recovery and statistic collection of a navigation sequence;
 - o Burson et al. discloses that automated browser functions include emulating all user input actions during navigation (column 10, lines 4-43 of Burson et al.) Burson et al. does not disclose the use of an API for integration purposes with the different functions. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an API to allow an application such as a browser to operate in conjunction with separate functions (i.e. Java applets – column 8, lines 13-45 of Burson et al.) because APIs are commonly used to provide

16. **Regarding dependent claim 19,**

- Functional programs include at least one of Web page data parsing, image search, failure-detection and dialog intercept;
 - o Burson et al. discloses a method in which the functional programs intercept the dialog necessary to navigate (i.e. cookie information) (column 8, lines 4-65 of Burson et al.).

Claim 20 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Burson et al. (US Patent Number 6,405,245, filed on October 28, 1998) as applied to claim 18 above, and further in view of Thompson et al. (US Patent Number 6,571,253, filed on April 28, 2000).

17. Regarding dependent claim 20,

- Search function includes determining a data structure tree defining how data is displayed in HTML;
 - Burson et al. does not disclose displaying the data structure in a tree format as part of the search function. However, Thompson et al. discloses a method in which in order to perform a search an HTML document is first broken down into a DOM tree which defines the hierarchal structure of the display of the document (column 2, lines 1-65 of Thompson et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of searching of Thompson et al. with the application of searching of Burson et al. because it would have increased the expressive power for locating the data item of interest.

Response to Arguments

18. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
February 14, 2005


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